

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

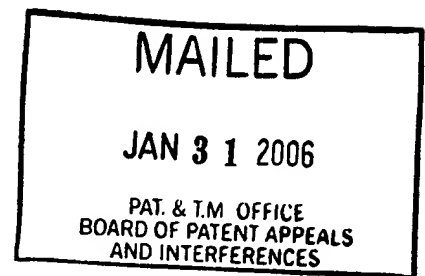
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC DAVID BLOCH, JEFFREY EVAN BEALL,
GORDON ANSON DURAND, and RALPH D. HILL

Appeal No. 2005-2523
Application No. 09/441,729

ON BRIEF



Before HAIRSTON, BARRETT and NAPPI, **Administrative Patent Judges.**

NAPPI, **Administrative Patent Judge.**

ON REQUEST FOR REHEARING

Appellants have filed a paper under 37 CFR § 41.52(a)(1) requesting that we reconsider our decision of October 27, 2005, wherein we affirmed the rejection of claims 1 through 19 under 35 U.S.C. § 103 as being unpatentable over Langford in view of DuLac.

Initially, we note that this request is filed pursuant to 37 CFR § 41.52(a)(1) which provides:

Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must

state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

Appellants assert, on page 2 of the request for rehearing:

The Board's Decision at page 12 states: "Contrary to appellants' arguments the claims do not include a limitation of transmitting "digitized video data". While independent claim 1 and independent claim 7 do not recite "digital" explicitly, the record prior to Appeal demonstrates that the Examiner and the Appellant understood that the term "rendering" referred to rendering digital media data. This issue was not in dispute. Rather, the Examiner, and Appellant disagreed as to the digital media data rendering capabilities of the Langford references off-line edit controller 30.

Appellants further assert that "[t]he Board's decision appears to use new, broadened definitions for the terms "rendering" and "media data", which in turn leads to a position that differs from that of the Examiner." On page 3 of the request for rehearing appellants identify sections of the specification which discuss rendering as including decompression, which appellants assert is only required if the movie data is in a compressed format.¹ Appellants assert that:

¹ We note that the passage from appellants' specification cited in the request for rehearing is on page 12 of the specification, not page 2 as argued. Further, we note the section cited by appellants does not specifically identify the "decompressor/renderer" as operating only on digital data. Lines 22 and 23 state that decompression is only required if the data is in compressed (i.e., MPEG (a digital format)) which, suggests to us that rendering applies to a broader range of data than just compressed digital files.

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The Examiner proffered the following definition for “rendering”: “To convert (graphics) from a file into visual form, as on a video display” (Final Office Action mailed April 7, 2004 at page 2). The record indicates that such a file is understood to be a digital file; hence rendering must logically render digital data from a digital data file.

Finally appellants request that we either reverse the examiner and state a new grounds of rejection (citing *In re Kumar* 418 F.3d 1361, 76 USPQ2d 1048 (Fed. Cir. 2005)) or recommend an amendment to the claims to explicitly include the word digital.

We are not persuaded by appellants’ argument that our decision was in error. The examiner stated on pages 5 and 6 of the answer that “rendering” is interpreted as “To convert (Graphics) from a file into visual form, as on a video display.” The examiner does not identify that the files are necessarily digital. Appellants acknowledge that the claims do not discuss digital data and request us to read a limitation from the specification into the claims. Our reviewing court has cautioned against such claim interpretation. “[I]nterpreting what is *meant* by a word *in* a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” (Emphasis original) *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing *Intervet Am. Inc v. Kee-Vet Labs., Inc.* , 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989). Thus, we are not convinced of an error in our decision.

Further, we decline appellants' request to designate the decision as a new grounds of rejection. We do not consider the interpretation of the claim term "rendering" in our decision to be different than that applied by the examiner. Thus, we see no reasons to designate our decision as a new grounds of rejection. Further, if appellants had presented a convincing argument that our interpretation of the claim is different from the examiner, we see no reasons to designate our decision as a new grounds of rejection. Claim interpretation is a question of law. ***Markman v. Westview Instruments, Inc.*** 52 F3d 967, 1000, 34 USPQ2d 1321, 1347 (Fed. Cir. 1995). In ***In re Kumar*** the board's decision was found to constitute a new grounds as "the board found facts not found by the examiner regarding the differences between the prior art and the claimed invention, which in fairness required an opportunity for response." ***In re Kumar*** 418 F.3d at 1367-68, 76 USPQ2d at 1052. As appellants have not presented an argument that our findings of fact differ from the examiner we do not consider that fairness requires designating the decision as a new grounds of rejection.

Further, we decline to recommend any amendments to the claims as prosecution of the application is closed, and any such claim amendments would require further examination. Appellants are free to file a request for continued examination in accordance with 37 CFR § 1.114 (a) to explore any amendments which may yield allowable subject matter.

Accordingly, while we have granted appellant's request for rehearing to the extent that we have reconsidered our decision, that request is denied with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (1) (iv).

REHEARING DENIED


KENNETH W. HAIRSTON
Administrative Patent Judge


LEE E. BARRETT
Administrative Patent Judge


ROBERT E. NAPPI
Administrative Patent Judge

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